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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,274	12/21/2000	James C. Ashby III	5007-00700	3193

7590

11/14/2002

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EXAMINER

SMITS, TALIVALDIS IVARS

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

13

# Office Action Summary

Application No.  
09/747,274

Applicant(s)  
James C. Ashby III et al.

Examiner  
Talivaldis Ivars Smits

Art Unit  
2654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 21, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

## DETAILED ACTION

### *Reissue Applications*

1. Applicants have filed for a reissue of U.S. Patent 5,852,803, issued on December 22, 1998 based on application 07/854,192 filed March 20, 1992. Applicants' Preliminary Amendment has added new claims 5-39.

2. Applicants' Declaration states the existence of two specific errors in the original patent wherein patentee claimed less than he had the right to claim, and which are to be corrected by the new claims presented in the Preliminary Amendment.. Specifically applicants' declaration regards reciting such a recording means, and reciting a bar coded label, respectively, as said two mistakes. However, these involve improper recapture of surrendered material, as discussed below.

3. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,852,803 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Allowable Subject Matter***

5. Claims 1-4 are allowed, because as claims 19-22 of the parent application 07/854,192, renumbered as claims 1-4, respectively, in U.S. Patent 5,852,803 they were deemed allowable, in response to applicants' arguments, over the prior art of record in the Decision on Appeal by the Board of Patent Appeals and Interferences, mailed July 31, 1997, for the following reasons (pages 6-9 of the Decision being herein summarized by the examiner):

Independent claim 1 (original claim 19 of parent application 07/854,192) is deemed allowable over Kondo in view of Tarlow because they do not teach nor fairly suggest a recordable releasibly secured product label which can be repetitively and reusably recorded. Dependent claims 2-3 (original claims 20-21) further limit claim 1 (original claim 19).

Independent claim 4 (original claim 22 of parent application 07/854,192) is deemed allowable over Dittakavi because he does not teach a voice recorder capable of recording a voice input and playing it back as a vocal message corresponding to a bar-coded label.

***Claim Rejections - 35 USC § 251***

6. New claims 5-39 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46

*USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).*

None of the independent nor dependent claims include either (or both) of the limitations, cited above in the reasons for allowance under **Allowable Subject Matter**, which made the parent application's patented claims allowable. Specifically, claims 5-39 do not recite a voice recorder capable of recording a voice input and playing it back as a vocal message corresponding to a bar code label.

As mentioned in paragraph 2, above, applicants regard inclusion of the voice recorder and the bar-coded label limitations as constituting the two errors which this reissue application is supposed to correct. However, if a limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Therefore, newly-added claims 5-39 are rejected as being improper recapture of surrendered subject matter.

### ***Conclusion***

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

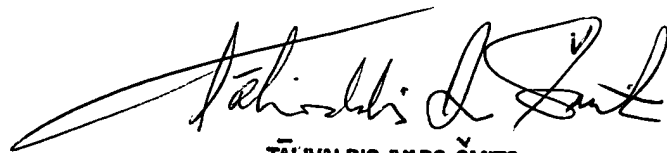
(703) 872-9314 (please label *formal* communications  
"OFFICIAL"; please label *informal* or draft communications,  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold, can be reached on (703) 305-4379. The facsimile phone number for Technology Center 2600 is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 customer service, whose telephone number is (703) 306-0377.



TĀLIVALDIS IVARS ŠMITS  
PRIMARY EXAMINER

Art Unit 2654  
November 12, 2002